

REMARKS

Applicants gratefully acknowledge Examiner's allowance of claims 25-30. Claims 25-37 are pending in the application. Claims 31, 33, and 35-37 have been amended. Support for the amendments and the new claims may be found throughout the specification. No new matter has been added.

In particular, support for the amendments to claims 31 and 33 may be found, for example, at page 42, lines 20-27. Support for the amendments to claim 35 may be found, for example at page 17, lines 19-23.

Amendment of claims should in no way be construed as an acquiescence to any of the Examiner's rejections. The amendments to the claims are being made solely to expedite prosecution of the present application and do not, and are not intended to, narrow the claims in anyway. Applicants reserve the option to further prosecute the same or similar claims in the instant or in a subsequent patent application.

Rejection of claims 31-37 under 35 U.S.C § 112, first paragraph

Claims 31-37 were rejected under 35 U.S.C. § 112, first paragraph, for reasons of written description. In particular, the Examiner alleges that the claims describe subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the invention at the time the application was filed. The rejection is respectfully traversed.

The Examiner states that claims 31-37 "recite a polypeptide comprising a fragment of SEQ ID NO: 2 comprising at least 30/50 amino acids." However, according to the Examiner, "the specification and claims do not indicate what distinguishing attributes are shared by the members of the genus." The Examiner further states that Applicants "have not described the function which is shared by the 30 consecutive amino acids of SEQ ID NO: 2 which would adequately describe the genus."

Applicants wish to note that claims 35-37 do not contain the language "comprising a fragment of SEQ ID NO: 2 comprising at least 30/50 amino acids." Accordingly, withdrawal of

the rejection of claims 35-37 is respectfully requested. Applicants will address the rejection only with respect to claims 31-34.

Applicants incorporate by reference their Response of April 3, 2003 which describes in detail the extensive teachings presented in the specification regarding structural and functional characteristics of FabI protein fragments. Additionally, while Applicants respectfully disagree with the rejection, the claims have been amended as suggested by the Examiner to identify a particular function shared by the members of the genus. In light of the remarks in the Response of April 3, 2003, and the claim amendments made herein, Applicants believe that the genus is adequately described. Accordingly, reconsideration and withdrawal of this rejection is respectfully requested.

Rejection of claims 31-37 under 35 U.S.C § 112, first paragraph

Claims 31-37 were rejected under 35 U.S.C. § 112, first paragraph, for allegedly containing new matter. Applicants respectfully disagree with the rejection, however, in an effort to expedite prosecution of the application, the objected to language has been canceled from the claims. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of claims 35-37 under 35 U.S.C. § 112, second paragraph

Claim 35 was rejected under 35 U.S.C. § 112, second paragraph, for reasons of indefiniteness. In particular, the Office Action alleges that the claim is indefinite for recitation of “stringent hybridization conditions.” Applicants respectfully disagree with the rejection, however, in an effort to expedite prosecution of the application, the objected to language has been canceled from the claims. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 35-37 were rejected under 35 U.S.C. § 112, second paragraph, for reasons of indefiniteness. In particular, the Office Action alleges that the claims are indefinite for recitation of “SEQ ID NO: 2, or its equivalent...”. Applicants respectfully disagree with the rejection,

however, in an effort to expedite prosecution of the application, the objected to language has been canceled from the claims. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of claims 35-37 under 35 U.S.C. § 102(e)

Claims 35-37 were rejected under 35 U.S.C. § 102(e) as being anticipated by Bailey et al. (U.S. Patent No. 6,403,337). The Office Action states that Bailey et al. “discloses a polypeptide of SEQ ID NO: 6 from *Staphylococcus aureus*” and teaches of “acceptable carriers for compositions and fusions with heterologous proteins (columns 102-111).” The Action further states that “SEQ ID NO: 6 comprises amino acid residues 1-256 that are 99.5% identical over amino acid residues 1-256 of SEQ ID NO: 1 as instantly claimed.”

The rejection is respectfully traversed.

At pages 4-5 of the Office Action, and as stated in previous actions, the Examiner alleges that Bailey et al. (U.S. Patent No. 6,403,337) has “full priority under 119(e) to provisional 60/009,861 filed January 5, 1996.” However, the filing date of the parent application (e.g., U.S.S.N. 60/009,861) may only be used as the 35 U.S.C. §102(e) date if the parent application properly supports the subject matter used to make the rejection under 35 U.S.C. §102(e) (see MPEP § 706.02(f)(1)). Applicants have examined U.S.S.N. 60/009,861 and were unable to find any subject matter that Applicants believe properly supports the current rejection. If the Examiner wishes to maintain this rejection, Applicants request that the Examiner point out with specificity the subject matter in U.S.S.N. 60/009,861 which supports the current rejection, including, for example, SEQ ID NO: 6 from U.S. Patent No. 6,403,337. In the absence of such a showing, Applicants assert that U.S. Patent No. 6,403,337 is not a proper reference under 35 U.S.C. § 102(e) because the earliest priority date for that patent which supports the subject matter used to make this rejection will fall after Applicants’ earliest filing date (August 28, 1996). Accordingly, reconsideration and withdrawal of the rejection is respectfully requested absent a showing by the Examiner to the contrary.

USSN: 09/292,411

Payne et al.

Conclusion

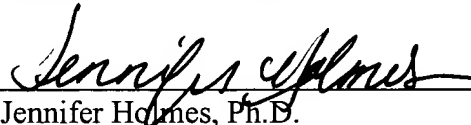
In view of the above remarks and the amendments to the claims, it is believed that this application is in condition for allowance. If a telephone conversation with Applicant's Attorney would expedite prosecution of the above-identified application, the Examiner is urged to call the undersigned at (617) 832-1000.

Respectfully submitted,

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